

## REMARKS

The Examiner is thanked for the thorough examination of this application. The Office Action, however, continued to reject all pending claims. The Office Action also objected to claims 1 and 16 for certain informalities. Regarding the rejections, the Office Action rejected claims 1-4 and 20-21 under 35 U.S.C. § 112, first and second paragraphs. The Office Action also rejected claims 1-2, 7, 12, and 16-17 under 35 U.S.C. § 102(e) as allegedly anticipated by Mowery et al. (US Patent 6,984,152). The Office Action also rejected claims 3, 4, 8, 20, and 21 under 35 U.S.C. § 103(a) as allegedly unpatentable over Mowery et al. (US Patent 6,984,152) in view of Jones et al (US Patent No. 6,438,638). Applicant has amended the specification and claims herein in such a way that renders the various objections and rejection moot. Notwithstanding, Applicant sets forth the following additional remarks.

For at least the reasons set forth hereinafter, Applicant respectfully requests reconsideration and withdrawal of the rejections.

### I. Discussion of Objections

In response to the objection to claims 1 and 16, Applicant has amended the term “double configuration connector interface” into “two system-end interfaces” for the same reasons in the last response and for the sake of consistency with what is referred to in pending claims. The two system-end interfaces includes a CONN1 in FIG. 4 and FIG. 7, which interfaces an ExpressCard to the adapter of the claimed embodiments, and an CONN2 in FIG. 4 and FIG. 7, which interfaces USB to the adapter of the claimed embodiments.

The term “storage media” in pending claims refers not only to CF cards, but also to other small storage cards such as MS, SD/MMC, SM or xD, as recited in paragraphs [0006], [0007], and [0010] of the specification.

The Applicant has added further limitations in the claims. Since all the limitations added by these amendments are fully supported by the original specification and drawings, no new matter is added to the application and withdrawn of this objections is respectfully request.

In short, claims 1 and 16 were objected to because of noted informalities. Applicants have amended claims according to Examiner’s suggestion to overcome the objections. Accordingly, withdrawal of the objections is respectfully requested.

## **II. Discussion of Objections of Claims 1-4, 7-8, 12, 16-17 and 20-21 and Rejections Under 35 § USC 112**

Claims 1-4, 7-8, 12, 16-17 and 20-21 stand ejected under 35 USC §112, first and second paragraphs. Applicants respectfully request reconsideration and withdrawal of these rejections for at least the following reasons.

The two system-end interfaces includes an CONN1 in FIG. 4 and FIG. 7, which interfaces an ExpressCard to the adapter of the claimed invention, and an CONN2 in FIG. 4 and FIG. 7, which interfaces USB to the adapter of the claimed embodiment.

The term “storage media” in pending claims refers to not only CF cards, but also other small storage cards such as MS, SD/MMC, SM or xD, as recited in paragraphs [0006], [0007] and [0010]. From paragraph [0006] of the specification, it is clear that there are some sockets of different sizes matching different storage media. CF card is exemplified in the embodiments while the architectures interfacing other kinds of

storage media to the adapter are well known and therefore is not necessary to such in details. As amended, claim 1 reads: "... a storage media interface, connected one of different kinds of storage media cards to the multiple format interface adapter...", in which the connection of storage media cards to the adapter is clearly NOT simultaneous.

Furthermore, all claims have been further amended to provide clear and proper antecedent basis for all terms, in accordance with the Examiner's suggestions. Claims 2, 4, and 12, which contained trademark/names of storage media have been cancelled without prejudice or disclaimer of the subject matter contained therein. Claim 20 has also been cancelled.

### **III. Discussion of Rejection of Claims 1-2, 7, 12 and 16-17 under 35 U.S.C. § 102(e)**

Claims 1-2, 7, 12, and 16-17 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by the newly cited reference of Mowery (US 6,984,152).

As amended, independent claim 1 recites:

1. A multiple format interface adapter for small storage media, comprising:

a storage media interface, connected one of different kinds of storage media cards to the multiple format interface adapter;

***two system-end interfaces, respectively complying with two different system-end formats, and used to connect the multiple format interface adapter to one of two different kind of system ends;*** and

a signal controller, converting signals between one of the two system-end interfaces and the storage media interface, when one of the storage media cards inserts in the multiple format interface adapter.

(*Emphasis added.*) Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

In contrast to the claimed embodiments, Mowery discloses a passive socket having a plurality of media card connectors, and a host connector connected to the media card connectors and ONE connector of the host computer, wherein the connector of the host computer conforms to a PCMCIA standard. Significantly, however, Mowery fails to teach or suggest claimed features of two system-end interfaces, respectively complying with two different system-end formats and are used to connect ONE of two different system ends to the socket, as expressly recited in amended claim 1 (and clearly supported by FIG. 4 and FIG. 7 of the specification).

Furthermore, a signal controller is configured to convert signals between one of the two system-end interfaces and the storage media interface. Clearly, Mowery lacks of such a signal controller.

For at least these reasons, amended claim 1 is allowable. As all remaining claims depend from claim 1, all pending claims patently define over the cited art.

#### **IV. Discussion of Rejection of Claims 1, 3-4, 8, 20 and 21 under 35 U.S.C. § 103(a)**

Claims 3 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly anticipated by Mowery et al in view of Jones et al and “PCMCIA Announcement Development for New Expansion Technology for Mobile and Desktop PCs”. Applicants respectfully request reconsideration and withdrawal of this rejection, in view of the amended claim language of independent claim 1. As claim 1 defines over Mowery for at least the reasons set forth above, claims 3 and 8 define over the combination of Mowery and Jones at least by virtue of their dependency from claim 1.

As a separate and independent basis for the patentability of independent claim 1, Applicants respectfully submit that there is no proper basis for selectively combining teachings from Mowery and Jones in the manner alleged by the Office Action (i.e., “for the benefit of increasing the number of types of memory card that can be read by the multiple format interface adapter properly and also implementing an active adapter, which can be used interchangeably connecting a different memory/memories of a device”).

It is well settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Simply stated, the rationale relied upon by the Office Action is clearly inconsistent with well established precedent and warrants a withdrawal of the rejections.

## CONCLUSION

For at least the foregoing reasons, it is believed that all of the pending claims 1, 3, 7-8, 16-17, 20 and a new claim 22 of the present application patently define over the prior art and are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

If Examiner has any questions regarding this filing or the application in general, Examiner is invited to contact the undersigned at 770-933-9500.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,



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